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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,336	10/10/2000	Tetsuyuki Kaneko	040256/0120	2188

7590 05/21/2002

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EXAMINER

CUNEO, KAMAND

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

9/684336

Applicant(s)

Examiner

Group Art Unit

NE

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/29/02
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) 7-10 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Treatment of Claims Based on Prior Art

1. 35 USC 103(a) states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Obviousness under 35 USC 103(a) is determined against a background established by the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), which are summarized in items 1-4 below.

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103(c) and potential 35 USC 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6 are rejected under 35 USC 103(a) as being unpatentable over Steyert, Jr. (US

4171464, hereafter Steyert).

Steyert discloses a wire with superconducting filaments (20) and a metallic covering (18) and ceramic (for example alumina) filaments (22) buried in the surface of the metal covering.

Steyert discloses the claimed invention except for the superconductor being of the oxide type (claim 1). Specifically, he does not disclose the superconductor to be of the Bi type (claim 5), and does not disclose that the metal covering is silver (claim 6). Nevertheless, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use oxide type superconductors, in particular Bi based ones, to increase the current capacity and increase the required operating temperature, because use of Bi based oxide superconductors is old. Further, it would have been obvious to one of ordinary skill at the time of the invention to use silver as the metal covering, because silver is the standard covering metal for oxide superconductors due to its inertness and its oxygen permeability. It has also been held that use of known materials based on their suitability for the intended is within the level of ordinary skill. *In re Leshin*, 125 USPQ 416.

Response to Arguments

4. Applicant's arguments have been fully considered, but are not persuasive.

Applicant argues that Steyert does not teach the claim because the ceramic material is within and throughout the core of the metal covering. This argument is not persuasive because the claim recites that the ceramic material be "buried in a surface" of the metal covering. Even if this surface is the outer surface, there is nothing precluding the existence of the ceramic material within the core as well. The claim is an open-ended claim with a "comprising" transitional phrase.

Applicant argues that the reason for incorporating the ceramic in the Steyert reference is

different from that of applicant. This is a moot point. The structure of the claim is disclosed by Steyert. Therefore, any benefits which may result from it are inherently provided. Furthermore, applicant does not claim any means plus function in the claims. Therefore, the arguments on functionality are moot given what is actually claimed.

Applicant concludes that the present invention and Steyert are different in construction. The only difference articulated is that of the ceramic material being throughout the metal covering. This configuration, however, is not precluded by the scope of the claim as discussed above. Therefore, there is no difference in construction between the *claimed invention* and Steyert.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

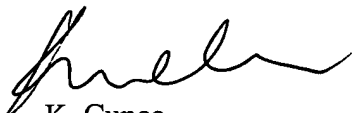
6. This application contains claims drawn to an invention nonelected with traverse in Paper No.

5. A complete reply to the final rejection must include cancelation of nonelected claims or other

appropriate action (37 CFR 1.144) See MPEP § 821.01.

Closing

7. Any inquiries related to the examination of this application should be directed to Ex. K. Cuneo at (703) 308-1233 or her supervisor Ex. J Gaffin at (703) 308-3301. Inquiries of a general nature should be directed to the receptionist of Group 2800 at (703) 308-0956. The fax numbers for Group 2800 are (703) 308-7722 and 7724.



K. Cuneo
Primary Examiner Group 2841
May 18, 2002